

### **REMARKS**

Claims 1-11, 40, 41, 46, 47, 52-77, 98 and 100-118 are pending in this application and have been rejected. Claims 1, 3, 62, 66, 72 and 77 are independent.

Claims 1-11, 40, 41, 46, 47, 52-77, 98 and 100-118 were rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-53 of "prior U.S. Patent No. 11/344,131." The Office Action stated this was a double patenting rejection.

This rejection is clearly in error. The rejection refers not to a patent, but rather, to copending application no. 11/344, 131. A double patenting rejection only can be based upon an issued patent, not an application.

Favorable reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1-11, 40, 41, 46, 47, 52-77, 98 and 100-118 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claims 1-53 of copending application no. 11/344,131. The Office Action stated this was a provisional double patenting rejection. Applicant respectfully traverses this rejection, and submits the following arguments in support thereof.

Applicant respectfully submits that such a rejection is improper because the same invention is not being claimed in these two cases. These cases do not meet the requirements set forth in M.P.E.P. § 804(II)(A) for such a rejection, which states:

#### ***A. Statutory Double Patenting — 35 U.S.C. 101***

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. 'Same invention' means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438,

164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a 'halogen' substituent is not identical to or substantively the same as a claim reciting the same compound except having a 'chlorine' substituent in place of the halogen because 'halogen' is broader than 'chlorine'....

Applicant will now show that the claims of this application and the claims of appln. no. 11/344,131 are directed to different inventions because the claims of this application could be literally infringed without literally infringing a corresponding claim in application no. 11/344,131, and *vice versa*. Consequently, this provisional double patenting rejection fails the test set forth in the M.P.E.P. and so is in error.

The claims of these two applications are reproduced in the table below.

Comparison of all the pending independent claims in this case, claims 1, 3, 62, 66, 72 and 77, to all the pending independent claims in appln. no. 11/344,131, claims 1, 16, 33, 38, 40 and 46, confirms that the two sets of claims are drawn to different and patentably distinct inventions:

**Appln. No. 09/786,208**

**Appln. No. 11/344,131**

<p>1. A transaction system for transacting through a communication network, comprising:</p> <p>a first terminal that is a vending machine connecting to the communication network and having an information indicating unit;</p> <p>a second terminal that is at least one of a cellular telephone and a PDA and having a unique ID information, an antenna and an input unit, said second terminal being connectable to said first terminal through the communication network with said antenna; and</p> <p>a transaction apparatus communicating with said first and second terminals through the communication network, said transaction apparatus storing said unique ID information of said second terminal in advance, said transaction apparatus setting up and sending a transaction ID information to said first terminal, said</p>	<p>1. A transaction system for transacting through a communication network, comprising:</p> <p>a first terminal connecting to the communication network and having an information indicating unit;</p> <p>a second terminal having a unique ID information and an input unit, said second terminal being located at a same site as said first terminal and connectable to said first terminal through the communication network; and</p> <p>a transaction apparatus communicating with said first and second terminals through the communication network, said transaction apparatus storing in advance said unique ID information of said second terminal, said transaction apparatus setting up a transaction ID information to be indicated on said indicating unit of said</p>
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<p>transaction apparatus receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus in advance previously.</p>	<p>first terminal, said transaction apparatus receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal and inputted through said input unit of said second terminal at the same site as said first terminal, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus in advance.</p>
<p>3. A transaction apparatus for transaction through a communication network with a first terminal that is a vending machine and a second terminal that is at least one of a cellular phone and a PDA and having a unique ID information and an antenna, said second terminal being connectable to said first terminal through the communication network with said antenna, comprising:</p> <p>a user database for storing said unique ID information of said second terminal in advance;</p> <p>a processing unit for setting up a transaction ID information to be indicated on said first terminal,</p> <p>a first communication unit for connecting to the first terminal via the communication network, said first communication unit sending the transaction ID information to the first terminal; and</p> <p>a second communication unit for connecting to the second terminal via the communication network and receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information that is transmitted from the first terminal to the second terminal,</p> <p>wherein said processing unit performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said user database.</p>	<p>16. A transaction apparatus for transacting through a communication network with a first terminal and a second terminal having a unique ID information, the transaction apparatus comprising:</p> <p>a user database for storing said unique ID information of said second terminal in advance;</p> <p>a processing unit for setting up a transaction ID information to be indicated on said first terminal,</p> <p>a first communication unit for connecting to the first terminal via a first communication network, said first communication unit sending the transaction ID information to be indicated on said first terminal to said first terminal; and</p> <p>a second communication unit for connecting to the second terminal via a second communication network and receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information that is indicated on said first terminal and inputted through said second terminal at the same site as said first terminal,</p> <p>wherein said processing unit performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said user database.</p>
<p>62. A method of a transaction system including a first terminal that is a vending machine, a second terminal that is at least one of a cellular phone and a PDA, and a transaction apparatus communicating with said first and</p>	<p>33. A method of transacting with a transaction system including a first terminal, a second terminal and a transaction apparatus communicating with said first and second terminals through a communication network, said</p>

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<p>second terminals through a communication network, said first terminal having an indicating unit, said second terminal having a unique ID information, an antenna and an input unit, and said second terminal being connectable to said first terminal through the communication network with said antenna, the method comprising:</p> <p>storing said unique ID information of said second terminal in said transaction apparatus in advance;</p> <p>connecting said first terminal with said transaction apparatus through the communication network;</p> <p>setting up a transaction ID information in said transaction apparatus;</p> <p>sending said transaction ID information to said first terminal;</p> <p>indicating said transaction ID information in said indicating unit of said first terminal;</p> <p>inputting said transaction ID information to said input unit of said second terminal by transmitting said transaction ID from said first terminal to said second terminal;</p> <p>receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal; and</p> <p>performing the transaction by synchronizing a communication with said first and said second terminals when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus.</p>	<p>first terminal having a indicating unit, said second terminal having a unique ID information and an input unit, and said second terminal being located at the same site as said first terminal and being connectable to said first terminal through the communication network; the method comprising :</p> <p>storing said unique ID information of said second terminal in said transaction apparatus;</p> <p>connecting said first terminal with said transaction apparatus through the communication network;</p> <p>setting up a transaction ID information to be indicated on said first terminal in said transaction apparatus;</p> <p>sending said transaction ID information to said first terminal;</p> <p>indicating said transaction ID information in said indicating unit of said first terminal;</p> <p>inputting said transaction ID information to said input unit of said second terminal at the same site as said first terminal;</p> <p>receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal; and</p> <p>performing the transaction by synchronizing a communication with said first and said second terminals when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus.</p>
<p>66. A recording medium which stores a program for a computer for a transaction system including a first terminal that is a vending machine, a second terminal that is at least one of a cellular phone and a PDA, and a transaction apparatus communicating with said first and second terminal through a communication network, said first terminal having an indicating unit, said second terminal having a unique ID information, an antenna and an input unit , and said second terminal being connectable to said first terminal through the communication network with the antenna, the recording medium comprising:</p>	<p>38. A recording medium which stores a program for a computer for a transaction system including a first terminal, a second terminal and a transaction apparatus communicating with said first and second terminal through a communication network, said first terminal having an indicating unit, said second terminal having a unique ID information and an input unit, and said second terminal being located at a same site as said first terminal, the recording medium comprising:</p>

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<p>a storing module which stores said unique ID information of said second terminal in said transaction apparatus;</p> <p>a connecting module which connects said first terminal with said transaction apparatus through the communication network;</p> <p>a setting up module which sets up a transaction ID information in said transaction apparatus;</p> <p>a sending module which sends said transaction ID information to said first terminal;</p> <p>an indicating module for indicating said transaction ID information in said indicating unit of said first terminal;</p> <p>an inputting module which inputs said transaction ID information transmitted by said indicating unit to said input unit of said second terminal;</p> <p>a receiving module which receives from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal; and</p> <p>a performing module which performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus.</p>	<p>a storing module which stores said unique ID information of said second terminal in said transaction apparatus;</p> <p>a connecting module which connects said first terminal with said transaction apparatus through the communication network;</p> <p>a setting up module which sets up a transaction ID information to be indicated on said first terminal in said transaction apparatus;</p> <p>a sending module which sends said transaction ID information to said first terminal;</p> <p>an indicating module for indicating said transaction ID information in said indicating unit of said first terminal;</p> <p>an inputting module which inputs said transaction ID information to said input unit of said second terminal at the same site as said first terminal;</p> <p>a receiving module which receives from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal; and</p> <p>a performing module which performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus.</p>
<p>72. A method of a transaction apparatus for transacting through a communication network with a first terminal that is a vending machine having an information indicating unit and a second terminal that is at least one of a cellular phone and a PDA and having unique ID information and an antenna, said second terminal being connectable to said first terminal through the communication network with said antenna, comprising:</p> <p>storing said unique ID information of said second terminal in advance;</p> <p>connecting to the first terminal via said communication network;</p> <p>setting up a transaction ID information to be indicated on said first terminal;</p>	<p>40. A method of transacting with a transaction apparatus for transacting through a communication network with a first terminal and a second terminal having unique ID information, the method comprising:</p> <p>storing said unique ID information of said second terminal in advance;</p> <p>connecting to the first terminal via a first communication network;</p> <p>setting up a transaction ID information to be indicated on said first terminal;</p>

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<p>connecting to the second terminal via said communication network;</p> <p>receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information transmitted by said first terminal and inputted through said second terminal at the same site as said first terminal; and</p> <p>performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in advance in said user database.</p>	<p>connecting to the second terminal via a second communication network;</p> <p>receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said first terminal and inputted through said second terminal at the same site as said first terminal; and</p> <p>performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in advance in said user database.</p>
<p>77. A recording medium which stores a program for a computer for a transaction apparatus for transacting through a communication network with a first terminal that is a vending machine having an information indicating unit and a second terminal that is at least one of a cellular phone and a PDA and having unique ID information and an antenna, said second terminal being connectable to said first terminal through the communication network with said antenna, comprising:</p> <p>a storing module which stores said unique ID information of said second terminal in advance;</p> <p>a setting up module which sets up a transaction ID information to be indicated on said first terminal;</p> <p>a first connecting module which connects to the first terminal via said communication network;</p> <p>a second connecting module which connects to the second terminal via said communication network;</p> <p>a receiving module which receives from said second terminal said unique ID information of said second terminal together with said transaction ID information transmitted by said first terminal and inputted through said second terminal; and</p> <p>a performing module which performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said user database.</p>	<p>46. A recording medium which stores a program for a computer for a transaction apparatus for transacting through a communication network with a first terminal and a second terminal having unique ID information, the recording medium comprising:</p> <p>a storing module which stores said unique ID information of said second terminal in advance;</p> <p>a setting up module which sets up a transaction ID information to be indicated on said first terminal;</p> <p>a first connecting module which connects the transaction apparatus to the first terminal via a first communication network;</p> <p>a second connecting module which connects the transaction apparatus to the second terminal via a second communication network;</p> <p>a receiving module which receives from said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said first terminal and inputted through said second terminal at the same site as said first terminal; and</p> <p>a performing module which performs the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said user database.</p>

By way of non-limiting example, in the following comparison claims 1 of these two applications have been marked with underlining to show how the claimed subject matters differs:

<u>Appln. No. 09/786,208</u>	<u>Appln. No. 11/344,131</u>
<p>1. A transaction system for transacting through a communication network, comprising:</p> <p>a first terminal <u>that is a vending machine</u> connecting to the communication network and having an information indicating unit;</p> <p>a second terminal <u>that is at least one of a cellular telephone and a PDA</u> and having a unique ID information, <u>an antenna</u> and an input unit, said second terminal being connectable to said first terminal through the communication network <u>with said antenna</u>; and</p> <p>a transaction apparatus communicating with said first and second terminals through the communication network, said transaction apparatus storing said unique ID information of said second terminal in advance, said transaction apparatus setting up <u>and sending</u> a transaction ID information to said first terminal, said transaction apparatus receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus in advance previously.</p>	<p>1. A transaction system for transacting through a communication network, comprising:</p> <p>a first terminal connecting to the communication network and having an information indicting unit;</p> <p>a second terminal having a unique ID information and an input unit, said second terminal <u>being located at a same site as said first terminal</u> and connectable to said first terminal through the communication network; and</p> <p>a transaction apparatus communicating with said first and second terminals through the communication network, said transaction apparatus storing in advance said unique ID information of said second terminal, said transaction apparatus setting up a transaction ID information <u>to be indicated on said indicating unit of said first terminal</u>, said transaction apparatus receiving from said second terminal said unique ID information of said second terminal together with said transaction ID information <u>indicated on said information indicating unit of said first terminal and inputted through said input unit of said second terminal at the same site as said first terminal</u>, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus in advance.</p>

In view of the teachings of M.P.E.P. § 804(II)(A), different inventions are clearly claimed.

As a non-limiting example, claim 1 of this application states the first terminal is a vending machine, whereas claim 1 of application no. 11/344,131 does not so provide. Consequently, application no. 11/344,131 could read literally on a first terminal that is not a vending machine, whereas this application would not.

Also by way of non-limiting example, application no. 11/344,131 states that the second terminal is located at the same site as the first terminal, whereas this application does not so provide. Consequently, this application could read literally on a system where the first and second terminals are at different locations, and application no. 11/344,131 would not.

The other independent claims in these applications likewise differ in literal scope, meaning M.P.E.P. § 804(II)(A) bars a same-invention type double patenting rejection. A comparison of claims 1, 3, 62, 66, 72 and 77 of this application to claims 1, 16, 33, 38, 40 and 46 of appln. no. 11/344,131, respectively, shows that each of the corresponding pairs of independent claims differs in at least one significant aspect, meaning the literal scope of those pairs of claims is not the same. The same invention therefore has not been claimed in the two applications.

For all the foregoing reasons, the claims pending in this application clearly are drawn to an invention that patentably distinct from the invention claimed in application no. 11/344,131. Consequently, this rejection is not well-taken, and so should be withdrawn.

Nor would an obviousness-type double patenting rejection be proper. Applying the teachings of M.P.E.P. § 804(II)(B)(1)<sup>1</sup>, it is clear that an obviousness-type double patenting rejection will not lie. The claims of this application are not anticipated by the claims of appln. 11/344,131. Nor would one skilled in the art familiar with the claims of application no. 11/344,131 be led to modify those claims to arrive at the invention claimed herein.

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<sup>1</sup> "A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) **because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).** See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of, an invention claimed in the patent? If the answer is yes, then an 'obviousness-type' nonstatutory double patenting rejection may be appropriate...."  
(emphasis added).



For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

**CONCLUSION**

Applicant respectfully submits that all outstanding rejections have been addressed and are now overcome. Applicant further submits that all claims pending in this application are patentable over the prior art. Favorable reconsideration and withdrawal of those objections and rejections is respectfully requested.

No fees are believed to be due in connection with the filing of this paper. Nevertheless, should any fee(s) be deemed now or hereafter due, the Commissioner is authorized to charge all such fees to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicant's attorney at the number listed below.

Respectfully submitted,

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